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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,144	12/21/2000	Wayne E. Cornish	ACS58266(15951)	2421
22852	7590	02/14/2006		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER MARMOR II, CHARLES ALAN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/746,144	<b>Applicant(s)</b> CORNISH ET AL.	
	<b>Examiner</b> Charles A. Marmor, II	<b>Art Unit</b> 3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7, 10 and 20-26 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 10 and 20-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment filed November 23, 2005. The Examiner acknowledges the cancellation of claims 1-5 and the addition of new claims 20-26. Claims 7, 10 and 20-23 are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 7, 10 and 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, upon further consideration, the claim language renders the claim indefinite. The limitations spanning lines 3-4 of the claim are unclear as to whether the second section is altered such that its properties are different from the properties of the first section and then "further alloyed with an easily diffusible element" or if the properties of the second section are altered by alloying with the easily diffusible element.

Regarding claim 23, the claim language renders the claim indefinite. It is unclear whether the distal end having at least one altered property is in addition to the second section having altered properties recited in claim 7 or if the distal end recited in claim 23 is the second section recited in claim 7.

Regarding claims 24 and 26, the limitation “the section” recited in line 1 renders the claims indefinite because it is unclear whether this limitation is referring to the second section recited in claim 7 or the distal end recited in claim 23.

***Claim Rejections - 35 USC § 102***

4. The indicated allowability of claims 7 and 10 is withdrawn in view of the newly discovered reference to Yamauchi et al. ('159). Rejections based on the newly cited reference follow.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7, 10 and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi et al. ('159). Yamauchi et al. teach an elongated medical device comprising a superelastic member formed from a nickel-titanium alloy. The device has a first, top end section having a first set of properties and an adjacent second, base section having a second set of properties that have been altered from the first set of properties. The second section may be alloyed with carbon, which is inherently an easily diffusible element in view of Applicant's disclosure. The altered properties of the second, base section include reduced superelasticity. The distal end of the superelastic member has at least one property that is altered from its original state through temperature treatments, and that property is also reduced superelasticity.

Regarding claims 24 and 26, since the entire superelastic member has properties that are altered from their original state and a length greater than 3cm, and it is unclear which section is being referred to in these claims as described above, it can be said that the section comprising at least one altered property is at least about 3 cm in length.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. ('159).

Yamauchi et al. discloses a superelastic member that is alloyed with an easily diffusible element, as described above, where said element is carbon. Yamauchi et al. does not disclose that the alloying element may be hydrogen or oxygen, which also inherently have easily diffusible properties in view of Applicant's disclosure. Applicant has not disclosed that using hydrogen or oxygen as the easily diffusible element rather than carbon solves any stated problem or is for any particular purpose. Moreover, it appears that the device of Yamauchi et al., or applicant's invention, would perform equally well with any of hydrogen, carbon or oxygen as the easily diffusible alloying element.

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Yamauchi et al. such that hydrogen or oxygen

is used as the easily diffusible element rather than carbon because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Yamauchi et al.

### ***Response to Arguments***

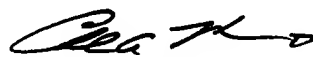
9. Applicant's arguments with respect to claims 7, 10 and 20-26 have been considered but are moot in view of the new ground(s) of rejection. Applicant contends that since claims 7 and 10 were indicated as allowable in the Office Action of August 23, 2005, new claims 20-26 also contain allowable subject matter. This argument is moot in view of the new grounds of rejection set forth hereinabove citing the newly discovered reference to Yamauchi et al. ('159).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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February 3, 2006